



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/746,769

12/26/2000

Ippo Aoki

04329.2483

9942

22852

7590

05/07/2004

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP

1300 I STREET, NW  
WASHINGTON, DC 20005

EXAMINER

DAO, MINH D

ART UNIT

PAPER NUMBER

2682

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/746,769

Applicant(s)

AOKI ET AL.

Examiner

MINH D DAO

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02/20/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,7,8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Tyneski (US Patent 5,584,054).

Regarding claim 7, Tyneski teaches A radio communication apparatus (see figs. 1 and 2; item 100; col. 1, lines 64-67; col. 2, lines 1-14) having a first mode (phone function) in which the apparatus emits radio waves and a second mode (personal organizer function) in which the apparatus does not emit radio waves, comprising: means for receiving an instruction (see fig. 1, item 108); and means for enabling the first mode when the apparatus is switched on, and for enabling the second mode when the receiving means thereafter receives a predetermined instruction (see fig. 2; col. 2, lines 50-55. In addition, it is inherently known that when the handset of reference Tyneski switched on, with the flap 104 in closed position, the phone function is activated.).

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen (US Patent 5,797,089) in view of Chmaytelli (US Patent 6,233,464).

Regarding claim 3, Nguyen teaches a radio communication apparatus, comprising:  
means for transmitting a radio signal (see fig. 3, item 32; col. 5, lines 23-30); means for processing information (see fig. 3, CPU 43); means for receiving an instruction (see fig.

3, item 23; col. 5, lines 53-56). However, Nguyen fails to teach means for enabling the processing means and enabling the processing means. Chmaytelli, in an analogous art, teaches means for enabling the processing means when the apparatus is switched on, and for enabling the processing means when the receiving means thereafter receives a predetermined instruction (col. 2, lines 6-9; col. 2, lines 24-33; col. 3, lines 36-37; in this case the PDA of reference Chmaytelli reads on the processing means and the telephone reads on transmission means of the present application). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the teaching of Chmaytelli to Nguyen in order to obtain coordination between the PDA and the Telephone during turning off process to prevent loss call or data missing when the PDA or the Telephone is improperly turned off as taught by Chmaytelli (col. 1, lines 33-35).

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen (US Patent 5,797,089) in view of Tyneski et al. (US Patent 5,584,054).

Regarding claim 8, Nguyen teaches a radio communication apparatus, comprising:  
means for transmitting a radio signal (see fig. 3, item 32; col. 5, lines 23-30);  
means for receiving a radio signal (see fig. 3, item 32; col. 5, lines 23-30);  
means for processing information (see fig. 3, RAM 42, Display screen 23);  
means for receiving an instruction (see fig. 3, item 23; col. 5, lines 53-56). However, Nguyen fails to teach means for prohibiting the radio signal transmission by the

transmitting means in accordance with the instruction, while keeping the processing means and the radio signal receiving means operable. Tyneski, in an analogous art, teaches means for prohibiting the radio signal transmission by the transmitting means in accordance with the instruction, while keeping the processing means and the radio signal receiving means operable (col. 2, lines 50-55; also see fig. 2). In this case, the Personal Organizer of reference Tyneski reads on the processing means and the Cordless Phone reads on the transmission means of the present application.). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the teaching of Tyneski to Nguyen in order to avoid having<sup>to</sup> carry separate devices for cordless phone and personal organizer that would be cumbersome for the user.

### ***Response to Amendment***

5. Applicant's arguments with respect to claims 3, 7, and 8 have been considered but are moot in view of the new ground(s) of rejection.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH D DAO whose telephone number is 703-305-5589. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN C CHIN can be reached on 703-308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Minh Dao  
Examiner  
Art Unit 2682  
April 27, 2004 *md*

  
VIVIAN CHIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600